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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

PRE APPLICATION OF

PASCAL SIMON

SERIAL NO: 09/986,264

FILED: NOVEMBER 8, 2001

FOR: COSMETIC ARTICLES HAVING
ENCAPSULATED LIQUID AND
METHOD OF MAKING SAME

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: EXAMINER: TRAN, S.

:

: GROUP ART UNIT: 1615

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REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is in reply to the Examiner's Answer of January 26, 2006.

There are two rejections of record in the present application. The first is of Claims 1-40 and 52-114 based on the combination of U.S. Patent No. 6,508,604 ("Bechmann") and WO-1/54661 ("Beck") and of Claims 52-114 based on the combination of these two references further in view of U.S. Patent No. 6,669,387 ("Gruenbacher").

In the Examiner's Answer of January 26, 2006, the Office has continued to fail to meet its burden in establishing a *prima facie* case of obviousness either because the prior art cited would not have been combined as the Office has done, the combination of references simply fails to teach or suggest all of the limitations of the claimed invention, and of most significance, the Office has failed to explain in detail why each of the claims would have been obvious in view of the combination of references in each of these two rejections. On these bases, the rejections are unsustainable and should be REVERSED.

On page 7 of the Examiner's Answer in the section entitled "Response to Argument" the Examiner points to the disclosure in Bechmann in column 3, lines 8-20 as allegedly rebutting Appellant's argument that Bechmann does not describe a cosmetic composition associated with a substrate wherein the liquid contained in the breakable capsule wets the composition upon breakage (referring to page 5, first paragraph of Appellant's Brief of November 1, 2005). The Examiner mischaracterizes the teachings of the reference in this section.

Nowhere in this section does Bechmann describe a cosmetic composition associated with a substrate such that the liquid contained in a breakable capsule wets this cosmetic composition upon breakage. As explained in Appellant's Brief of November 1, 2005 at page 5 the inventions described in Bechmann and Beck are directed to completely different aspects of controlling delivery of composition, i.e., Bechmann is to controlling delivery of liquid compositions whereas Beck there is no control of the liquid (i.e., water) added to the substrate.

On page 8 of the Examiner's Answer of January 26, 2006 the Examiner cites page 36, last paragraph of Beck as allegedly teaching "the therapeutic or cleansing benefit may be released from the articles chambers by popping, bursting, squeezing. Once again, the Examiner mischaracterizes the teachings of Beck in that the chambers are not burstable capsules but sections within the substrate itself for separating various components from each other; the example provided is for separating surfactant containing components from conditioning components. This disclosure however does not minimize the fact that the Beck article must be immersed in water or placed in the direct steam of water (i.e., no control of the amount of water applied to the substrate) and is in direct contrast to the teachings of Bechmann which requires all components encapsulated to control the quantity and direction of flow of those compositions.

On page 8 of the Examiner's Answer of January 26, 2006, the Examiner states:

regarding the argument that the article taught by Beck must be wetted with water before use, while the article taught by Bechmann is dry, it is noted that nothing in Bechmann prevent the user from wetting the article before use. In other words, the article taught by Bechmann may already be wetted before the active composition in the cell released.

First, appellant never argued that Bechmann must be dry and never can be wet and therefore, he Examiner mischaracterizes Appellant's argument. Second, the Examiner has missed the point. Bechmann wishes to keep all materials within the capsules to control the delivery and flow of those materials upon bursting of the capsules. Whereas Beck is to adding a large amount of water from an external source to wet the substrate containing surfactant and/or conditioner, which wetted substrate can then be used for cleansing and/or conditioning as needed. Appellant reiterates the alleged motivation to combine these disclosures are only found in the present claims and the Office's hindsight reconstruction of the same. There simply would not have been motivation to modify Beck to include the capsules from Bechmann because doing so would be contrary to the teachings that Beck states are essential to the invention, i.e., immersion in a stream of water. Bechmann would not have been modified by including a cosmetic composition associated with the substrate because doing so would go against Bechmann's essential teachings which is to provide a means for controlling "the flow and direction of the cells' content." Moreover, if one were to modify Beck in view of Bechmann, the result would simply be to include all of the ingredients in the cells.

In the paragraph bridging pages 8-9 of the Examiner's Answer of January 26, 2006 the Examiner once again mischaracterizes the teachings of the primary reference of Bechmann when citing column 6, lines 10-67 of the same as allegedly teaching "easy-opening means," including an inverted protrusion that comes inside out and bursts to release

the cell's contents." This disclosure is used by the Examiner to allege that the limitation in Claims 31 and 105 ("a container includes means for breaking said at least one breakable capsule") was taught by the cited references. This is factually incorrect.

As stated in Appellant's Brief at page 9, third paragraph, the Office's reliance on this section of Bechmann is misplaced because Bechmann does not describe a container with a means for breaking the capsule but rather provides a number of ways in which to modify the cell itself to facilitate breakage. Such modifications of the capsule itself includes laser scoring (column 6, line 17), "providing the cell with at least one elongated portion" (column 6, lines 32-34), providing "a peeling area located at the interface between the dome of the cell and its bottom part" (column 6, lines 54-55), creating a "bow-ring shaped cell" (column 7, line 13), providing "a pull string which is attached to at least one portion of the cell" (column 7, lines 22-23), and "at least one peelable seal, said at least one peelable seal further comprising a pull string" (column 7, lines 43-44). Thus, it is clear that Bechmann does not describe or suggest a container with a means for breaking said at least one breakable capsule as set forth in Claims 31 and 105. Therefore, the Office has failed to establish a *prima facie* case of obviousness for these claims.

It is further noted that the Office has failed to provide any specific rationale or explanation as to why Claims 52, 82, 95, 103 and 114 are obvious in view of the combination of Bechmann and Beck. This was also pointed out in Appellant's Brief of November 1, 2005 (see page 11, pages 13-16; and page 18). Simply on this basis, the Office has failed to establish that these claims are not patentable in terms of 35 U.S.C. §103 and the rejections on these claims cannot be sustained and therefore should be REVERSED.

As discussed in Appellant's Brief at page 12, second paragraph there is no description or suggestion in the combination of Bechmann and Beck for the specific arrangement set forth in Claim 52 for at least three layers and within these three layers a first breakable

capsule, a second breakable capsule (with a first material) and a second material positioned such that the first and second materials from the specific positions mix to produce an exothermic reaction.” As discussed in Appellant’s Brief on pages 14-15, the combination of Bechmann and Beck fails to provide any description or suggestion for the specific arrangement set forth in Claim 82 that is the three substrate layers, moisture impermeable ply, and capsules specifically positioned with compositions within these layers.

As discussed in Appellant’s Brief at pages 16-17, there is nothing in the combination of prior art references which provide a description or suggestion for the specific arrangement set forth in Claims 95 and 114 that is substrates with pockets including breakable capsules containing compositions as set forth in those claims.

As discussed on pages 18-20 of Appellant’s Brief, the arrangement set forth in Claim 103 is not described or suggested by the combination of Bechmann and Beck because the cited publications fail to provide any disclosure or suggestion for including a breakable capsule and a pocket as defined in Claim 103.

At page 9 of the Examiner’s Answer of January 26, 2006 the Examiner states “in this case, Gruenbacher is relied upon for the teachings of rupturable articles that contains three or more substrate layers...Thus, it would have been obvious to one of ordinary skill to modify the article of Bechmann and Beck in view of the teachings of Gruenbacher to obtain the claimed invention.” Appellant disagrees and notably, the Office in its Answers has once again failed to set forth detailed reasons why the specific arrangements in Claims 52, 82, 95, 103, 105 and 114 (the independent claims rejected in rejection #2) would have been obvious. Therefore, the Office has failed to meet its burden of establishing a *prima facie* case of obviousness and the rejection should be REVERSED. As set forth in Appellant’s Brief at pages 22-24 detailed reasons as to why the combination of these three references do not render the claimed invention obvious have been provided. Rather than reiterate all of these

arguments here for the sake of brevity, Appellant notes that these references fail to suggest the arrangements claimed in Claims 52-114 because the references are directed towards different purposes and objectives as compared with the present invention. As the references fail to disclose or suggest the advantages achieved by the present invention, the cited references fail to render obvious the subject matter of those claims.

On pages 25-27 of Appellant's Brief of November 1, 2005, detailed reasons as to why various dependent claims all contain further limitations that establish their patentability apart from those in independent Claims 1, 31, 52, 82, 95, 103 and 114 have been provided. Notably, the Office has once again failed in its Answer to set forth detailed reasons why the specific arrangements in these dependent claims would have been obvious. Therefore, the Office has failed to meet its burden of establishing a *prima facie* case of obviousness and the rejections based on the combination of Bechmann and Beck and the rejection based on these two references in view of Gruenbacher cannot be sustained and should be REVERSED. As explained in Appellant's Brief at pages 25-27 the cited art simply would not have been combined to render the present invention obvious. The references themselves do not suggest the combination proffered in the Office's rejections and, absent Applicant's own disclosure, one skilled in the art would not have modified the references suggested in the Office Action.

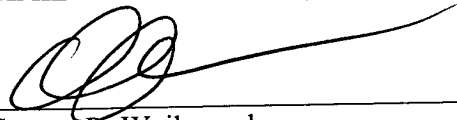
Accordingly, in view of the above in combination with the reasons set forth in Appellant's Appeal Brief of November 1, 2005 all pending claims should be indicated as being allowed.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
DJP/rac

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven P. Weihrouch
Registration No. 32,829

Daniel J. Pereira, Ph.D.
Registration No. 45,518